TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. [illegible].

LEWIS MOORE, PLAINTIFF IN ERROR,

vs.

JAMES MARSH, P. MEYER, CHARLES C. SHOEKLEY, AND [illegible] SHOEKLEY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE [illegible] OF PENNSYLVANIA.

FILED [illegible], 1878.

SUPREME COURT OF THE UNITED STATES.

No. 239.

LEWIS MOORE, PLAINTIFF IN ERROR,

vs.

JAMES MARSH, P. BEAVER, CHARLES C. SHORKLEY, AND ELISHA SHORKLEY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE WESTERN DISTRICT OF PENNSYLVANIA.

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1 Among the rolls, records, and judicial proceedings of the Circuit Court of the United States in and for the western district of Pennsylvania (in the third circuit) may be found the following words and figures, to wit:

United States Circuit Court, western district of Pennsylvania.

Trespass on the case.

LEWIS MOORE
vs.
JAMES MARSH, P. BEAVER, CHARLES C. SHORKLEY, and Elisha Shorkley.

CLERK: Issue summons against James Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley, returnable according to law. Indorse, "Suit brought to recover damages for the infringement of reissues," Nos. 1,394, and 1,395 of letters patent, for improvement in grain drills granted to plaintiff, dated April 18th, 1848; extended April 18th, 1862, and reissued February 3rd, 1863. Damages, $10,000."

SAM'L S. FISHER, *Pl'ff's Att'y.*
BRUCE & NEGLEY, *Pl'ff's Att'y.*

Whereupon the following summons was issued:

1½ UNITED STATES, *Western District of Pennsylvania, set.:*

The President of the United States to the marshal of the western district of Pennsylvania, greeting:

We command you that you summon James Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley, late of your district, if they may be found therein, so that they be and appear before the judges of the Circuit Court of the United States in and for the western district of Pennsylvania, in the third circuit, at a session of the same court, to be holden at Pittsburg, on the first Monday of September next, to answer to Lewis Moore in an action on the case for the infringement of reissue Nos. 1,394 and 1,395 of letters patent for improvement in grain drills; and have you then there this writ.

Witness the Honorable Salmon P. Chase, esquire, Chief Justice of the Supreme Court of the United States, at Pittsburg, this 17th day of August, A. D. 1866, and in the 91st year of the independence of the said United States.

[SEAL.] H. SPROUT, *Clerk.*

[50-cent int. rev. stamp.]

2 Upon which is the following endorsement:

I hereby authorize and depute T. Church, esq., to execute the within writ.

A. MURDOCK, *U. S. M.*

AUGUST 23RD, 1866.

T. Church, sh'ff, on oath saith that he served the within writ on James Marsh, Peter Beaver, C. C. Shorkley, and Elisha Shorkley, by handing each a true and attested copy of the same.

T. CHURCH.

Sworn and subscribed before me, Aug't 23, 1866.

C. H. HASSENPLUG, *Proth'y.*

And also upon the same day, to wit, August 17th, 1866, comes the plaintiff, by counsel, and files the following declaration.

[Copy of declaration.]

3 Circuit Court of the United States for the third circuit and western district of Pennsylvania.

Trespass on the case.

LEWIS MOORE
vs.
JAMES S. MARSH, P. BEAVER, CHARLES C. SHORKLEY, and Elisha Shorkley.

The plaintiff, Lewis Moore, comes and complains of the defendants, James S. Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley, in a plea of trespass on the case, for that whereas Lewis Moore before and at the time of making of the letters patent, and of the committing the grievances by the said defendants hereinafter next mentioned, was the original and first inventor of a certain new and useful improvement in grain drills, to wit, at Bart, in the State of Pennsylvania, to wit, in the district aforesaid, and thereupon heretofore, to wit, on the eighteenth day of April, A. D. 1848, at the city of Washington, to wit, in the district aforesaid, certain letters patent, under the hands of the Secretary of State of the United States, with the seal of the Patent Office of the United States thereto affixed, countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid, were
4 granted to the said Lewis Moore, whereby was grantad and secured to the said Lewis Moore, his heirs, administrators, or assigns, for the term of fourteen years from [from] the said 18th day of April, A. D. 1848, the full and exclusive right and liberty of making, construction, using, and vending to others to be used, the said invention and improvement, a full and exact description of which, with the mode of constructing and applying the same, is set forth in the written specification or description of the said Lewis Moore, in the words of the said Lewis Moore, filed in the Patent Office of the United States before the granting of said letters patent, and made part of the same, as by reference to the aforesaid specification or description now remaing of record in the Patent Office will more fully and at large appear.

The plaintiff further says that said invention and improvement so patented was new and useful; that the said Lewis Moore was at the time of application for said patent citizen of the United States; that he was the original and first inventor of said invention and improvement so patented; and that the same was not known or used before his said invention, and was not in public use, or on sale with his consent or allowance, for more than two years before his application for said letters patent.

5 The plaintiff further says that afterwards, on the 18th day of April, 1862, by the certificate of the Commissioner of Patents of the United States, under his hand, with the seal of the Patent Office of the United States affixed thereto, duly entered and recorded in the Patent Office, the said letters patent were duly reviewed and extended for the term of seven years, from and after the expiration of the first term of fourteen years aforesaid, and thereby declared to have the same effect in law as though they had been originally granted for the term of twenty-one years.

The plaintiff further says that afterward, to wit, on the 3d day of February, A. D. 1863, such proceedings were had that the said letters patent were surrendered by reason of a defective specification, and three several new patents were issued to said inventor, numbered respectively, 1,393, 1,394, and 1,395, for distinct and separate parts of the thing patented in said original patent, for the residue of the unexpired period of the said original and extended letters patent, which said several reissued letters patent were signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents of the United States, and sealed as aforesaid, and granted and secured to said inventor the rights aforesaid, as by said reissue No. 1,393, now of record in the Patent Office, and said reis-

6 sues Nos. 1,394 and 1,395, which the plaintiff now brings into court, will fully appear.

[Amendment. And the said plaintiff further says, that from the said 3rd day of February, 1863, to the 24th day of February, 1865, he was the sole owner, among other territory, of the county of Union, in the State of Pennsylvania.]

The plaintiff further says, that he has heretofore made, constructed, used, and vended to be used, said invention and improvement, to his great advantage and profit, to wit, at the district aforesaid.

Yet the said defendants, well knowing the premises, but contriving and wrongfully intending to injure the said plaintiff, and to deprive him of the profit, benefit, and advantage, which he might, and otherwise would have derived and acquired from the making, constructing, using, and vending to others to be used, the said invention, improvement, after the making of said reissued letters patent, and within the said term of years in the said extended letters patent mentioned, to wit, on the third day of February, A. D. 1863, at Lewisburg, in the county of Union, Pennsylvania, to wit, in the district aforesaid, and on divers other days and times between that day and the [amendment "twenty-forth day of Febuary, 1865,"] un-

7 lawfully and unjustly, against the will of said plaintiff, and

without the leave or license of said plaintiff, did make and use, and vend to others to be used, a large number, to wit, one thousand grain drills, in imitation of said invention, in breach of said letters patent, and in violation and infringement of the exclusive right thereto, so as aforesaid acquired by the plaintiff, and contrary to the form of the statutes in such case made and provided, whereby the said plaintiff has been greatly injured and deprived of a great part of the profits and advantages which he might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid, to the actual damage of the plaintiff ten thousand dollars, and therefor he brings this suit by his attorneys.

SAMUEL S. FISHER.
BRUCE & NEGLEY.

And afterwards, to wit, March 7th, 1867, comes the pl'ff, by counsel, and files the following præcipe for rule to plead:

8 In the Circuit Court of the U. S., west. D., Penn'a.—No. 112.—Nov. T., 1866.

Copy of præcipe.

LEWIS MOORE
vs.
MARSH AND OTHERS.

Enter rule on the defendants to plead in thirty days or judgment.

BRUCE & NEGLEY,
Pl'ff's Att'ys.

To H. Sproul, clerk.
Mar. 7, 1'67.

Upon which the following rule was issued:

In the Circuit Court of the United States for the western district of Pennsylvania.—No. 112.—November term, 1866.

Copy of rule.

LEWIS MOORE
vs.
MARSH AND OTHERS.

And now, to wit, March 7th, 1867.
Rule to plead in one month or judgment.
From the record.
[SEAL.]

H. SPROUL, *Clerk.*

And afterwards, to wit, April 6th, 1867, comes def'ts, by counsel, and files the following plea:

9 U. S. Circuit Court, western dist. of Pennsylvania.—No. 112.—Nov. term, 1866.

Copy of plea.

LEWIS MOORE
vs.
JAMES MARSH *et al.*

And the said defendants, by W. Bakewell, their attorney, came and defend the wrong and injury, where, &c., and say that the said supposed reissued letters patent, reissues No. 1,394 and 1,395, are not, nor was either of them, granted for the same invention as that for which the original letters patent in said declaration mentioned was granted to the said plaintiffs, but that the alleged invention or inventions, described and claimed in the schedule or specification accompanying said reissued letters patent, reissues No. 1,394 and No. 1,395, in said declaration mentioned, is or are substantially different from the alleged invention or inventions described in said original letters patent in said declaration mentioned, whereby, and by reason whereof, the said supposed reissued letters patent, reissues No. 1,394 and 1,395, in said declaration mentioned, and the supposed grant of privilege in the declaration alleged to be thereby made, were and are null and void and of none effcet, and this the said defendants are ready to verify. And for a further plea in this behalf, the said defendants say that they are not guilty of the said supposed grievances in the declaration above laid to their charge, or any or either of them, or any part thereof, in manner and form as the plaintiff hath thereof above in the declaration complained against them, the said defendants; and of this the said defendants put themselves upon the country, &c.

W. BAKEWELL,
Attorney for Defendants.

10 And afterwards, to wit, Oct. 8th, 1867, comes defendants, by counsel, and files the following special matter.

U. S. Circuit Court W. dist., Pa. Nov. term, 1866.

Copy of special matter.

LEWIS MOORE,
vs.
JAMES MARSH *et al.* } No. 112.

To the above-named plaintiff or his attorneys:

You will please to take notice that on the trial of the above-entitled action the defendants will, under the general issue pleaded therein, and in pursuance of the act of Congress in such case made and pro-

vided, give in evidence the act of Congress, and also the following special matter, to wit:

That the said patentee (Lewis Moore) was not the original and first inventor or discoverer of the thing patented in said reissued patent, reissue No. 1,394, mentioned in his declaration, or of a substantial and material part thereof herein of specified and claimed as new in said reissues, letters patent No. 1,394, but that the said improvement therein claimed or specified and patented, or a substantial and material part thereof, was as were invented by or known to and in public use by Samuel Pennock and Marton Pennock, or one of them, prior to the alleged invention thereof by said plaintiff, the patentee
11 aforesaid; that said Samuel Pennock and Marton Pennock then resided at East Marlborough, in the county of Chester, and State of Pennsylvania; that said Marton Pennock is since deceased, and that said Samuel Pennock now resides at Kennett Squa, in the county of Chester, and State aforesaid.

Further, that the said Improvement or improvements claimed as specified and patented in said reissues letters patent, No. 1,394, or a substantial and material part thereof, was as were well known toor in public use by the following-named persons, prior to the supposed invention or discovery thereof by the said patentees, to wit, Emma Harvey, Achilles Hollingsworth, and Jacob Pearson, all of whom now reside at Wilmington, in the county of New Castle, and State of Delaware; Samuel B. Ferry, then of Cloumes, in the county of Lancaster, and State of Pennsylvania, who is since deceased; John Jones, then and now residing on his farm near Middletown, in the county of New Castle, and State of Delaware; Doctor Mandam, then and now residing in or near New Castle, in the county of New Castle, and State of Delaware; Henry Musselman, then and now residing at Paradise, near the city of Lancaster, in the county of Lancaster, and State of Pennsylvania; Jacob Brenneman, then and now residing near the
12 city of Lancaster aforesaid, on the Philadelphia and Lancaster turnpike; Pierce Wilmer, residing at or near Centrevill, in Queen Annis county, in the State of Maryland; Richard B. Carmichal and William B. Carmichael, residing in Queen Anns county, in the State of Maryland, and in the vicinity of Centreville aforesaid; Pierpont Seymour, residing at East Broomfield, in the county of Ontario, and State of New York; and Henry Stoner, residing at West Lamp township, in the county of Lancaster, and State of Pennsylvania; and further, that the places where the thing patented in said reissued letters patent, No. 1,394, or a substantial and material part thereof, had been used prior to the supposed invention or discovery thereof by said patentee, are the several places hereinbefore mentioned and given as the residences of the said persons hereinbefore named as having had or possessed or prior knowledge of the thing or things patented.

And further, that the thing patented and described, or specified and claimed in said reissued letters patent, No. 1,394, or a substantial and material part thereof, had been in public use, or in sale, for more than two years prior to this original application of said Lewis

Moore for a patent, the knowledge of such prior use having been possessed by the following named persons, (being the same
13 persons hereinbefore mentioned,) to wit: Morton Pennock, Samuel Pennock, John Jones, Doctor Mandam, Pierre Wilmer, Richard B. Carmichael, William Carmichael, Henry Musselman, Jacob Brenneman, Samuel B. Ferry, Pierpont Seymour, Harry Stoner and Jacob Pearson; that the residence of said persons last named, respectively, is the same as is hereinbefore stated, and that the places where such prior use was had and known was at or near the several places hereinbefore named as the residence of said persons respectively.

And further, that the said letters patent reissues, No. 1,394 and 1,395 respectively, are broader and specify and claim as the invention of said plaintiff more than that which was actually invented or dicovered by said patentee.

Yours, &c.,

W. BAKEWELL,
Att'y for Defendants.

Pittsburg, April 13, 1867.

We hereby accept service of the above and foregoing notice this day of April, A. D. 1867.

14 And now, to wit, Nov. 12th, 1867, comes plaintiff and defendants, by counsel, and file the following agreement:

United States Circuit Court, western district Pennsylvania, Nov. term, 1866.

Copy of agreement.

LEWIS MOORE, *vs.* MAFFIT & OLD. } No. 111.

LEWIS MOORE, *vs.* JAMES MARSH *et al.* } No. 112.

And now, to wit, on the 12th day of November, A. D. 1867, came the parties above named, whereupon it is ordered, the counsel for all parties in the above cases appearing and consenting thereto, that the above case be heard together on the third Tuesday of December next, or as soon thereafter as the case can be reached, and the counsel for all parties having waived a jury, it is ordered that said cases be heard by the court without the intervention of a jury, the judgment of the court in the premises to have in all the respects the same effect as the verdict of a jury.

Per curiam.

15 And now, to wit, Dec. 19th, 1867, comes plaintiff by counsel, and leave being granted, files the following amendment to declaration :

United States Circuit Court, western district of Pennsylvania, Nov. T., 1866.

Copy of amendment.

LEWIS MOORE
vs.
JAMES MARSH *et al.* } No. 112.

And now comes the said plaintiff, and by leave of the court first had and obtained, amends his declaration herein by adding after the averment as to the reissues the following paragraph : "And the said plaintiff further says that from the said 3rd day of February, 1863, to the 24th day of February, 1865, he was the sole owner, among other teritory, of the county of Union, in the State of Pennsylvania," and also by striking from the last page of said declaration the words "commencement of this suit," and inserting in lieu thereof the words "twenty-fourth day of Febuary, 1865," as by said declaration, as amended, will fully appear.

SAMUEL S. FISHER,
Pl'tff's Att'y.

15½ And also upon the same day, to Dec. 19th, 1867, the court grant leave to defendants to file special plea.

United States Circuit Court, western district of Pennsylvania, of Nov. term, 1866.

Copy of special plea.

LEWIS MOORE
vs.
JAMES S. MARSH *et al.* } No. 112.

And for further plea in this behalf the said defendants, by leave of the court here for this purpose first had and obtained, say that the said plaintiff ought not to have or maintain his aforesaid action thereof against them, because they say that the said plaintiff at the time of commencing this suit had not any exclusive right in the said reissued letters patents in his said declaration mentioned, either as patentee or as assignee, or as grantee, of the exclusive right within or throughout any part of the United States; and especially that said plaintiff had not, at the time of the commencement of this action, the exclusive right in said letters patent within that part of the United States within which it is alleged in said declarations that the said defendants had committed the supposed grievances therein
16 above complained of, to wit, within the western district of Pennsylvania, but that the said plaintiff, before the commencement of this action, to wit, on or about the 8th day of March, A. D.

1856, by an instrument of writing of that date, did assign, sell, and set over unto Caleb Pierce and S. B. Black a certain interest in the original letters patent in said declaration mentioned, in the following words and figures, to wit:

"Whereas I, Lewis Moore, did obtain letters patent of the United States for certain improvements in seed planters, which letters patent bear date the eighteen day of April, A. D. 1848;

"And whereas Caleb Peirce, and S. B. Black are desirous of acquiring an interest therein:

"Now, this indenture witnesseth, that for and in consideration of the sum of one dollar to me in hand paid, I have assigned, sold, and set over, and do hereby assign, sell, and set over unto the said Caleb Peirce and S. P. Black all the right, title, and interest which I have in the said invention as secured to me by the said letters patent, in, for, and to the counties of Northampton, Lehigh, Berks, Cumberland, Franklin, Adams, and York, in the State of Pennsylvania, the counties of Washington, Harford, and Baltimore, in the State of Maryland; the counties of Louden, Jefferson, Berberley, Clark, and Frederick,
17 in the State of Virginia; and in and for the townships of Coventry, East Coventry, South Coventry, East Nanternial, West Vincent, East Vincent, East Pheland, West Pheland, Richland, Charlestown, Schuylkill, West Whiteland, East Whiteland, Trendyfin, East Town, Willistown, East Goshen, West Goshen, East Bradford, West Bradford, West Town, Thornbury, Birmingham, Warwick, East Fallowfield, Pocopsin, in the county of Chester, and state of Pennsylvania, and in no other place or places.

"The same to be held and enjoyed by the said Caleb Peirce and S. B. Black, for their own use and behoof, and for the use and behoof of their legal representatives, to the full end of the term for which said letters patent are or may be granted, or extended, as fully and entirely to all intents and purposes as the same would or could have been held, possessed, and enjoyed by me, had this assignment and sale not been made."

In testimony whereof, I have hereunto set my hand and seal this eighth day of March, A. D. one thousand eight hundred and fifty-six.

[SEAL.] LEWIS MOORE.

Signed, sealed, and delivered in presence of—

ELI W. MOORE.

GEORGE HUNTER.

18 Which assignment or transfer was duly recorded in the United States Patent Office.

And that said plaintiff also, before the commencement of this action, to wit, on or about the eighth day of May, A. D. 1862, by an instrument of writing of that date, did assign, sell, and set over unto Norton Davis, Levi L. Lawrence, and Wilson Jones, known as the firm of Davis, Lawrence & Co., a certain interest in and claim under said extended letters patent in his said declaration mentioned in the following words and figures, to wit:

"Whereas I, Lewis Moore, of Ypsilantei, county of Wastenan and State of Michigan, (but for. of Bart, Pa.,) did obtain letters patent of the United States for certain improvements in seed planting, dated April 18th, 1848, for the term of fourteen years, which were extended by the Commissioner of Patents for a term of seven years from the eighteenth day of April, 1862;

And whereas Norton Davis, Levi L. Lawrence, and Wilson Jones, known as the firm of Davis, Lawrence & Co., of the town of Dublin, county of Wayne, and State of Indiana, are desirous of obtaining an interest therein:

Now this indenture witnesseth, that for and in consideration of one thousand dollars, and other valuable considerations to me in
19 hand paid, the receipt whereof is hereby acknowledged, I have assigned, sold, and set over, and do hereby assign, sell, and set over to the said Davis, Lawrence & Co. all my right, title and claim in said extended patent for, to, and in the State of Indiana; also an undivided half interest in said extended patent in the States of Ohio, Kentuckey, Tennesee, North Carolina, South Carolina, Georgia, Florida, Alabama, Mississippi, Louisiana, Arkansas, Missouri, Illinois, Iowa, Wisconsin, Minnesota, Kansas, Texas, California, and Oregon; also a half interest in all the organized Territories of the United States, and in no other place or places, for their own use and behoof, and for the use and behoof of their legal representatives, to the full end of the term for which said letters patent are granted, as fully and entirely as the same would have been held and enjoyed by myself had this assignment and sale not have been made."

In testimony whereof I have hereunto assigned my name and affixed my seal this eighth day of May, A. D. 1862.

[SEAL.] LEWIS MOORE.

Witness:

SAM'L R. GREER.

"Which assignment or transfer was duly recorded in the United States Patent Office.

"And that said plaintiff also, before the commencement of
20 this action, to wit, on or about the 24th day of Febuary, 1865, by an instrument of writing of that date, did assign, sell, and set over unto one Wilson Jones an undivided half of all his, the said plaintiff's, their remaining right, title, and interest in said reissued patents in said declaration mentioned within and throughout the United States, in the following words and figures, to wit:

"Whereas I, Lewis Moore, of Ypsilante, Wastenan county, Michigan, (but formerly of Bart, Pennsylvania,) did obtain letters patent of the United States for certain improvements in seed planters, dated April 18th, 1848, for the term of fourteen years, which was extended by the Commissioner of Patents for seven years from the 18th day of April, 1862, and on the 3rd day of Febuary, 1863, was surrendered, reissued, divided into three reissued patents numbered 1,393, 1,394, and 1,395, respectively;

"And whereas, on the eighth day of May, 1862, I did assign and convey to Norton Davis, Levi L. Lawrence, and Wilson Jones, of Dublin, Wayne county, Indiana, all my right, title, and interest in the State of Indiana, and the one undivided half of my right, title, and interest in said reissued patents within and for the States of
Ohio, Kentucky, Tennessee, North Carolina, South Carolina,
21 Geogia, Florida, Alabama, Mississippi, Louisiana, Arkansas,
Missouri, Illinois, Iowa, Wisconsin, Minnesota, Kansas, Texas, California, and Oregon, and in all the organized Teritories of the United States;

"And whereas, Wilson Jones, of Dublin, Wayne county, Indiana, is desirous of acquiring an interest in the remaining States of the Union:

"Now this indenture witnesseth, that for and in consideration of the sum of one dollar and other valuable considerations, the receipt whereof is hereby acknowledged, I have assigned, sold, and set over and do hereby assign, sell, and set over to the said Wilson Jones, one undivided half of all my right, title, and interest in the said three reissued letters patent in the States of the United States not included in the above-mentioned assignment to Davis, Lawrence and Jones, (except the State of Michigan,) to the full end of the term for which the said reissued letters patent are granted, as fully and entirely as the same would have been held and enjoyed by us if this assignment and sale had not been made.

In testimony whereof I have hereunto set my name and affixed my sea, this 24th day of Febuary, A. D. 1865.

22 [SEAL.] LEWIS MOORE.

Witness:

SAM. S. FISHER.

JAMES MOORE.

[L. M., Feb. 24, 1865.]

Which assignment and transfer was duly recorded in the United States Patent Office.

And therefore that the said plaintiff hath no right, under the patents in said case made and provided, to bring this action in his own name against the said defendants.

And this the said defendants are ready to verify.

Wherefore they pray judgment if the said plaintiff ought to have or maintain his aforesaid action against them.

Dec. 19, 1867.

W. BAKEWELL,
Att'y for Def'ts.

23 And further, upon the same day, Dec. 19th, 1867, the plaintiff, by counsel, demurs to plea of defendants.

United States Circuit Court, western district of Pennsylvania, Nov. term, 1866.

Copy of demurrer.

LEWIS MOORE
vs.
JAMES S. MARSH *et al.* } No. 112.

And now comes the plaintiff, and says that the plea filed by the defendants herein, by leave of court, on the 19th day of December, 1867, and the matters therein contained, in manner and form as the same are above pleaded and set forth, are not sufficient in law to bar or preclude him, the said plaintiff, from having or maintaining his aforesaid action thereof against the said defendants, and that he, the said plaintiff, is not bound in law to answer the same; and this he, the said plaintiff, is ready to verify; therefor by reason of the insufficiency of the said plea in this bhalf, the said plaintiff prays judgment, and his damages by him sustained on occasion of the committing of the said grievances, to be adjudged to him, &c.

SAMUEL S. FISHER,
Plff's Att'y.

24 And now, to wit, Dec'r 19th, 1867, this cause came on to be heard on demurrer, and was argued on part of pl'ff by S. S. Fisher, esq., contra by Messrs. Bakewell and Baldwin, esq., and the court, being fully advised in the premises, orders judgment for defendants on demurrer; and therefore it is considered that the defendants go hence without day and recover of the plaintiff their costs in this behalf expended.

25 Know all men by these presents that we, Samuel S. Fisher and Richard E. Breed, are held and firmly bound unto James Marsh, P. Beaver, Charles C. Sharkley, and Elisha Sharkley, in the full and just sum of two hundred dollars, to be paid to the said James Marsh, P. Beaver, Charles C. Sharkley, and Elisha Sharkley, their certain attorney, executors, administrators, or assigns, to which payment, well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents. Sealed with our seals, and dated this third day of January, in the year of our Lord one thousand eight hundred and sixty-eight.

Whereas lately at a Circuit Court of the United States for the western district of Pennsylvania, in a suit depending in said court between Lewis Moore, plaintiff, and James Marsh, P. Beaver, Charles C. Sharkley, and Elisha Sharkley, defendants, judgment was rendered against the said Lewis Moore; and the said Lewis Moore having obtained a writ of error and filed a copy thereof in the clerk's
26 office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said James Marsh, P.

Beaver, Charles C. Sharkley, and Elisha Sharkley, citing and admonishing to be and appear at a Supreme Court of the United States, to be holden at Washington, the first Monday of December next:

Now, the condition of the above obligation is such, that if the said Lewis Moore shall prosecute his writ of error to effect, and answer all damages and costs if he fail to make his plea good, then the above obligation to be void, else to remain in full force and virtue.

[SEAL.] SAM'L S. FISHER.
[SEAL.] RICHARD E. BREED.

Sealed, and delivered in presence of—
E. G. HALL.

Approved by—
WILSON McCANDLESS, *U. S. Judge.*

27 I, Henry Sproul, clerk of the Circuit Court of the United States in and for the western district of Pennsylvania, do hereby certify that the foregoing is a true and correct copy of the record and proceedings had at No. 112, November term, 1866, wherein Lewis Moore is plaintiff, and James Marsh *et al.* defendants. And further, that I have carefully examined and compared the same with the original on file in this office, and that it is a true, correct, and literal copy thereof.

In testimony whereof I have hereunto set my hand and affixed the seal of said court this 30th day of December, A. D. 1867.

[SEAL.] H. SPROUL, *Clerk.*
Per H. D. GAMBLE, *Deputy.*

[5-ct. U. S. int. rev. stamp.]

28 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the judges of the Circuit Court of the United States for the western district of Pennsylvania, greeting:

Because, in the record and proceedings, as also in the rendition of the judgment of a plea, which is in the said Circuit Court before you between Lewis Moore, plaintiff, and James Marsh, P. Beaver, Charles C. Shorkley and Elisha Shorkley, defendants, a manifest error has happened, to the great damage of the said Lewis
29 Moore, as by his complaint appears, we, being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the first Monday of December, A. D. 1867, in the said Supreme Court to be then and there held, that the record

and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right and according to the laws and custom of the United States should to be done.

Witness the Honorable Salmon P. Chase, Chief Justice of the said Supreme Court, the third of January, in the year of our Lord one thousand eight hundred and sixty-eight.

_____, _____,
Clerk of the Supreme Court of the United States.

Allowed by—

WILSON McCANDLESS,
U. S. District Judge, sitting at Circuit.

30 The United States of America to James Marsh, P. Beaver, Charles C. Shorkley and Elisha Shorkley, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the first Monday of December, A. D. 1867, pursuant to a writ of error filed in the clerk's office of the Circuit Court of the United States for the western district of Pennsylvania, wherein Lewis Moore is plaintiff in error, and you are defendants in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Salmon P. Chase, Chief Justice of the Supreme Court of the United States, this third day of January, in the year of our Lord one thousand eight hundred and sixty-eight.

WILSON McCANDLESS,
U. S. District Judge, sitting at Circuit.

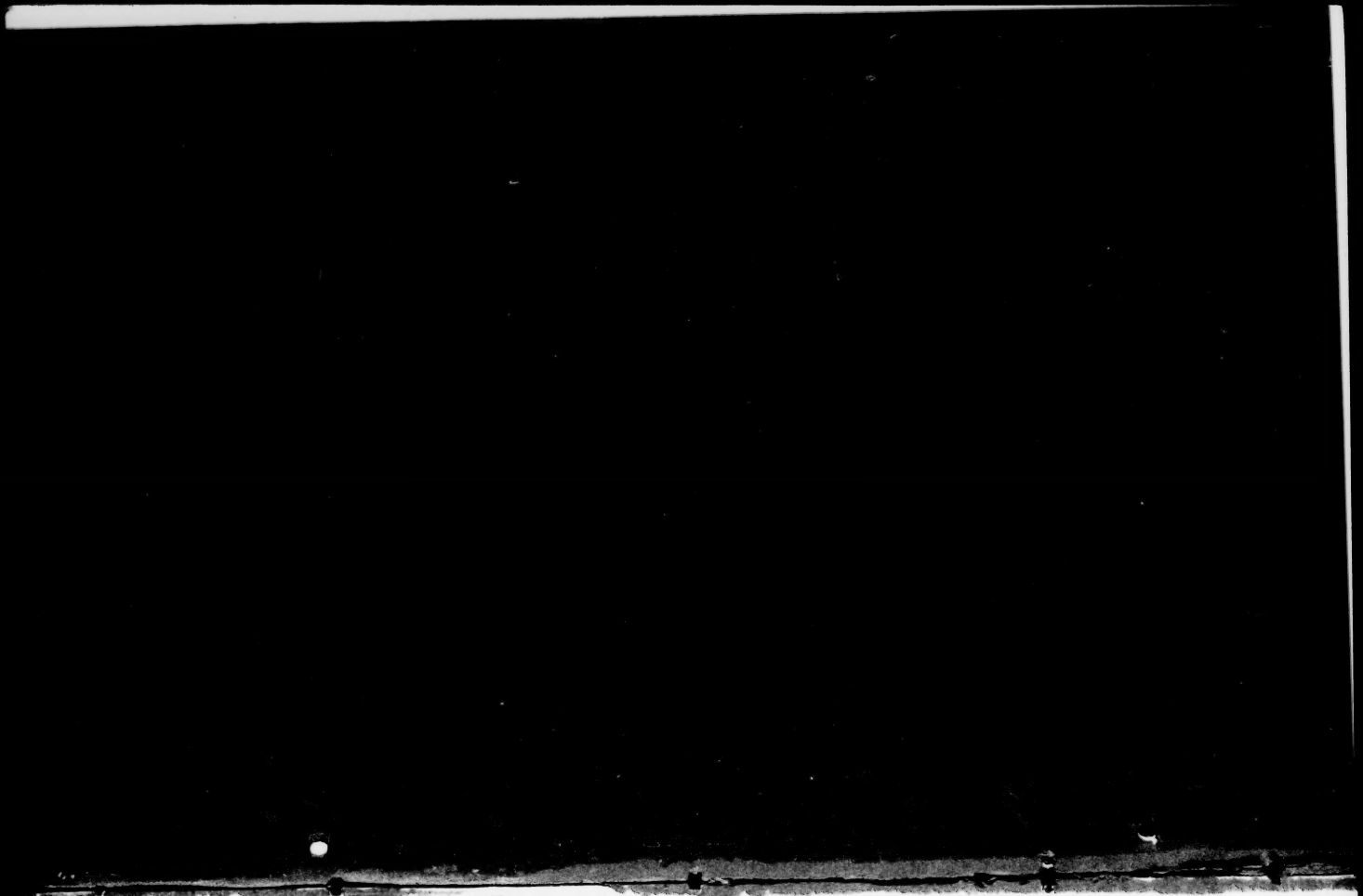
31 On this day of , in the year of our Lord one thousand eight hundred and , personally appeared before me, the subscriber, , and makes oath that he delivered a true copy of the within citation to .

Sworn to and subscribed the , A. D. 18 .

Service of the within citation is hereby accepted on behalf of the defendants in error, and it is agreed that said case may stand for argument on brief, as if filed on the first day of the December term, 1867, under rule XX of the rules of the Supreme Court, provided that the pl'ff in error serves his printed argument on counsel for def't in error within 30 days hereafter, and that the def'ts in error have 30 days thereafter within which to file their printed argument.

January 3d, 1868.

W. BAKEWELL,
Att'y for Def'ts in Error.



Robert Clarke & Co., Printers, 65 West Fourth Street, Cincinnati.

Supreme Court of the United States,

DECEMBER TERM, 1867.

Lewis Moore,
PLAINTIFF IN ERROR.

versus

James Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley,
DEFENDANTS IN ERROR.

Error to the Circuit Court of the United States for the Western District of Pennsylvania.

Brief for Plaintiff in Error.

THE point in controversy in this case is single and simple.

Lewis Moore was the patentee of certain improvements in grain drills, for which letters patent issued to him April 18, 1848. During the lifetime of the original patent, he sold to Caleb Pierce and S. B. Black the counties of Northampton, Lehigh, Berks, Cumberland, Franklin, Adams, and York, in

Pennsylvania; certain counties in Maryland and Virginia; and certain townships in Chester county, Pennsylvania, to the end of the term for which said letters patent "are or may be granted or extended."

The patent was extended for seven years from April 18, 1862.

On February 3, 1863, the patent was surrendered and reissued in three divisions.

On February 25, 1865, the patentee conveyed the one undivided half of all his right, title, and interest in the State of Pennsylvania (among other territory) to Wilson Jones.

Suit was brought in November, 1866, by the patentee in his own name, without joining Jones, or anybody else, to recover damages for the infringement of the patent by the defendants, who manufactured and sold drills in Union county, Pennsylvania; for the drills made and sold by them between February 3, 1863, and February 25, 1865, the period during which he was sole owner of the patent within and for said Union county.

These facts appear by the amended declaration and the special plea filed December 19, 1867.

It appears, then:

1. That Moore never sold Union county, Pennsylvania, to any one until February 25, 1865, when he sold one-half of it to Jones.

2. That he brought suit in his own name to recover the damages which accrued during the period when he was sole owner.

3. That this action, although brought by its terms to recover damages accruing prior to February 25, 1865, was in fact commenced after February 25, 1865, to wit: in November, 1866.

4. That when the suit was actually brought, Wilson Jones owned half of Union county, Pennsylvania, though nothing appears to show that he had any interest, by deed, in the damages accruing before the conveyance to him.

On this state of facts, the defendants claimed that a suit for the infringement of a patent must be brought in the name of a party or parties owning the patent *at the time of the suit*, although the suit might be brought to recover damages accruing during a time when those parties had no interest in the patent. That the damages were an incident to the patent, which rolled up upon it like a traveling snowball, and brought to the last owner the patent, with all its accumulations of damages. And this, although it might have passed through many hands. In other words: that if A obtains a patent, owns it one year, and assigns to B, and B owns it one year and assigns to C, and C owns it one year and assigns to D, and the patent is infringed during the ownership of each of those parties, that D may sue for and recover the whole damages from the issue of the patent, that he is the only person who can sue for an infringement, whether occurring during the ownership of A, B, or C. Nay, that if the patent is infringed only while A owns it, but no suit is brought until it is conveyed to D, D must sue for A's damages. How the fund is to be distributed, or under what authority, does not appear. Why this would not be the assignment of unliquidated damages, is not clearly shown.

The Court sustained this plea, overruled the demurrer to it, and gave judgment for the defendants.

It can not be doubted that joint patentees or assignees of a patent are tenants in common.

Pitts v. *Hall*, 3 Blatch. 201.
Vose v. *Singer*, 4 Allen, 226.
Mathers v. *Green*, Law Rep. 1 Ch. App. 29.

Now it never was doubted that tenants in common could not join in an action to recover damages for trespass to an estate, which, though now belonging to them, was, when the damages accrued, the sole property of one of them.

1 Chitty on Pleadings, 64, 65.

I can see no reason for an exception in patent cases. In fact, it is believed to be every day's practice, to charge a jury, that a recovery can only be had, or damages given, *since the assignment to plaintiff*. No one ever dreamed that an assignment of a *patent*, by mere operation of law, carried with it all the *back damages* to the last assignee.

Relief from this obvious proposition is sought in the language of the latter part of section 14 of the Act of July 4, 1836, which says:

"And such damages may be recovered by action on the case, in any Court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States."

It is said that the words "name of the person interested," mean "persons interested *in the patent at the time of the bringing*

of the suit." I think they mean only "persons interested in the patent *at the time when the cause of action accrued.*"

It seems to me that if the legislature meant to upset the rule of the common law upon this subject, and to provide a statute of descent by which the damages should all fall into the lap of the last assignee, the intention would have been clearly set forth.

I frankly confess not to have fully comprehended the argument of my learned friends upon this point, though this was, doubtless, no fault of theirs.

Why the conveyance to Pierce and Black of other counties in Pennsylvania was put into the special plea, I do not know. They had no interest in Union county; even if the words, "are or may be granted or extended," conveyed to them anything more than an equitable title to the counties named, under the extension, which I doubt. The extension was then *in posse* only. It was not of right, but a remote contingency resting in the discretion of the Commissioner. But, be that as it may, their interest was limited. They were not even assignees, but "grantees of the exclusive right within and throughout a specified part of the United States."

Section 14, Act of 1836.
Section 11, Act of 1836.
Potter v. *Holland*, 1 Fisher's Pat. Cases, 327.

They might, if they had the legal title, sue in their own territory, but they had nothing to do with a suit as to Union county where the venue was laid.

The same remarks apply to the deed to Davis, Lawrence & Co. also set out in the plea. No part of Pennsylvania was

conveyed to them. No one owned a scintilla of interest in Union county, Pennsylvania, from February 3, 1863, to February 25, 1865, except Lewis Moore. He alone, therefore, could sue for damages accruing, by reason of infringement, during that time. He did so sue, limiting his right of recovery to that period, and was put out of Court by a plea alleging that, *after that time*, he sold an interest in that county to some one else.

This, it is respectfully submitted, was error.

SAMUEL S. FISHER,
Counsel for Plaintiff in Error.

Supreme Court of the United States,

DECEMBER TERM, 1867.

Lewis Moore,
PLAINTIFF IN ERROR

versus

James Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley,
DEFENDANTS IN ERROR.

Brief for Plaintiff in Error.

SAMUEL S. FISHER,
Counsel for Plaintiff in Error.

Spiller's Print, Pike's Opera House Building.

Supreme Court of the United States,

DECEMBER TERM, 1868.

Lewis Moore,
PLAINTIFF IN ERROR.

versus

James Marsh, P. Beaver, Charles C. Shorkley, and Elisha Shorkley,
DEFENDANTS IN ERROR.

Additional Brief for Plaintiff in Error.

IN addition to the brief heretofore filed, the attention of the Court is called to the case of *Dean* v. *Mason*, 20 How. 198. This was a suit in equity for the infringement of a patent. Pending the suit, but before final decree, the complainant, Mason, sold all his interest to Baker & Smith. The defendant moved to dismiss the bill, and subsequently for leave to file a supplemental bill in the name of the assignees. Both motions were denied. The Supreme Court say:

"The motion to dismiss the complainant's bill, upon proof that they had parted with all their interest in the

subject-matter of the suit, was properly overruled. The allegation is that Mason parted with his title in April, 1852, and the account of the profits is brought down only to the 29th of August, 1851. *The right asserted in this action was not affected* by the conveyance of Mason to Baker & Smith.

"The refusal of the Circuit Court to permit a supplemental bill to be filed by Baker & Smith, was, under the circumstances, a matter of discretion in the Court; and it affords no ground for the reversal of the decree. *It is not perceived what interest these assignees could have in a suit for an infringement of a patent before their right accrued;* and any attempt to make them parties, with the view to benefit the defendants in the pending suit, was unsustainable."

And yet, it is claimed in the present suit that the assignment of a patent, carries with it all the damages, and that the assignees are not only interested in infringements occurring before their right accrued, but that they are the only persons who *are* interested in such infringements.

It is submitted that the case cited is in direct conflict with this theory.

SAMUEL S. FISHER,

Of Counsel for Plaintiff in Error.

Supreme Court of the United States.

DECEMBER TERM, 1867.

LEWIS MOORE,

Plaintiff in Error,

VS.

JAMES MARSH, P. BEAVER, CHARLES C. SHARKLEY, and ELISHA SHARKLEY,

Defendants in Error.

ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE WESTERN DISTRICT OF PENNSYLVANIA.

E. C. Markley & Son, Printers, 422 Library St., opposite the Post Office, Phila.

Supreme Court of the United States.

DECEMBER TERM, 1867.

LEWIS MOORE, *Plaintiff in Error*,

vs.

JAMES MARSH, P. BEAVER, CHARLES C. SHARKLEY and ELISHA SHARKLEY, *Defendants in Error.*

Error to the Circuit Court of the United States for the Western District of Pennsylvania.

Brief for Defendants in Error.

The plaintiff obtained Letters Patent for Improvement in Grain Drills, April 18th, 1848.

By assignment, dated March 8th, 1856, he sold "all the "right, title and interest which I have in the said invention, as "secured to me by the said Letters Patent, in, for and to the "Counties of Northampton, Lehigh, Berks, Cumberland, Frank-"lin, Adams and York, in the State of Pennsylvania; the "Counties of Washington, Hereford and Baltimore, in the State "of Maryland; the Counties of Loudon, Jefferson, Berkley, "Clarke and Frederick, in the State of Virginia, and in and

"for" twenty-six Townships of Chester County, Pennsylvania, "to the full end of the term for which said Letters Patent are "or may be granted or extended, as fully and entirely to all "intents and purposes," &c.

This assignment left in Moore only a sectional interest in his Patent.

April 18th, 1862, the patent was extended.

May 8th, 1862, the patentee (plaintiff) assigned to Norton Davis, Levi L. Lawrence and Wilson Jones "all my right, title "and claim in said extended patent for, to and in the State of "Indiana; also an undivided half interest in said extended "patent in the States of Ohio, Kentucky, Tennessee, North "Carolina, South Carolina, Georgia, Florida, Alabama, Missis-"sippi, Louisiana, Arkansas, Missouri, Illinois, Iowa, Wiscon-"sin, Minnesota, Kansas, Texas, California and Oregon; also "a half interest in all the organized Territories of the United "States."

The original patent was surrendered and three reissues taken out February 3d, 1863.

February 24th, 1865, the patentee, (plaintiff,) after reciting the above stated assignment to Davis, Lawrence and Jones, and further reciting, "whereas, Wilson Jones, of Dublin, Wayne "County, Indiana, is desirous of acquiring an interest in the "remaining States of the Union," assigns to said Jones "*one undivided half of all my right, title and interest in the said three reissued Letters Patent in the States of the United States not included in the above mentioned assignment to Davis, Lawrence and Jones, (except the State of Michigan.*") This, of course, including the State of Pennsylvania.

It will thus be seen that at the time of bringing the suit, (November, 1866,) the plaintiff owned no right whatever in some parts of Pennsylvania, and had none other than an undivided half interest in the patent in *any part of that State.*

The defendants *manufactured* Drills at Lewisburg, Union County, Pennsylvania.

The sole question arising upon this record is thus presented: Can the patentee, as sole plaintiff, maintain his action against these defendants, notwithstanding his having assigned such interests and rights as above set forth, and while only owning a fractional interest in the patent within some portions of the State, and having no right whatever in other portions?

The defendants filed a plea to the effect that the plaintiff ought not to maintain his action because that, at the commencement of this suit he had not any *exclusive* right in the patent declared upon, either as patentee, assignee, or as grantee of the exclusive right, within or throughout a specified part of the United States.

The plaintiff then amended his declaration, so as to claim damages only for the time intervening between February 3, 1863, the date of the re-issue, and February 24, 1865, the date of his assignment to Wilson Jones.

On his declaration, as thus amended, the plaintiff insists that he has a right to sue, in his own name, to recover damages during the time he was sole owner, although at the time when suit was brought he had ceased to have any exclusive interest in said patent.

The defendants claim, that in an action at law for infringement of a patent, the suit must be brought in the name, or names, of the person, or persons, interested *in the patent*, either as patentees, assignees, or grantees, of the exclusive interest within or throughout a specified part of the United States.

This has been the uniform interpretation of the 14th section of the Act of Congress of July 4, 1836, relative to patents, construed with reference to the 11th section of the same act, which provides that "every patent shall be assignable in law either as to the whole interest, or any undivided part thereof by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent to make and use, and to grant to others to make and use the thing patented within and throughout any specified part or portion of the United States, shall be recorded," &c., &c.

That the words, "the person or persons interested, whether as patentees, assignees, or grantees of the exclusive right within and throughout a specified part of the United States, in the 14th section, which specifies *in whose name* the suit for damages may be brought, means interested *in the patent*, and not interested *in the damages*, is manifest.

1. By compa ring this with the 11th section above cited.

2. By the fact that *licensees* are excluded, and yet they are frequently the only parties interested in the damages, while the plaintiff in such cases is the party interested as patentee, assignee, or grantee of an exclusive right, and has no interest in the damages.

3. From the decisions of this Court and of several of the Circuit Courts.

Gayler *vs.* Wilder, 10 How., 493.

Washburn *vs.* Gould, 3 Story, 131, 167.

Suydam *vs.* Day, 2 Blatch, 23.

Goodyear *vs.* McBurney, 3 Blatch, 32.

Blanchard *vs.* Eldridge, 1 Wallace, Jr., 340.

The law has been so understood, as is witnessed by the uniform practice of the profession.

But the argument is used by the plaintiff that if this be law then if A owns a patent and assigns it to B, and B assigns it to C, and C assigns to D, each of them owning it for one year successively, the last owner must sue for the damages accruing during the ownership of his predecessors; that D alone can sue, but that how the fund is to be distributed does not appear.

The argument is a very unfortunate one for the plaintiff, because it reminds us so forcibly of the reasoning employed by the Supreme Court (Taney, C. J.,) in Gayler *vs.* Wilder, 10 How., 494–5, in which it is decided that a licensee (although the party damnified, and entitled to the damages) cannot maintain the suit, but that the action must be brought in the name of the party or parties representing the entire or exclusive legal title.

The Court say: "Such a division would inevitably lead to fraudulent impositions upon persons who desire to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority to be harassed by a *multiplicity of suits instead of one.*" And Mr. Justice Grier, in Blanchard *vs.* Eldridge, Wall., Jr., 341, uses this argument *ab inconvenienti* in determining the meaning of the 11th section of the Act, and says "the Act of Congress has not subjected even a pirate of the machine to fifty different suits by fifty several assignees, whose several interests might be affected."

Now if, as claimed by the plaintiff, a party who, in mistake as to his rights, may have infringed a patent during a number of years, is to be exposed at the end of the term to as many separate suits for infringement as there have been separate owners of the patent during the time he has been using it; he may have to defend against fifty separate actions brought by as many different plaintiffs for what has been a continuous act of user of the patented machine. Such a monstrous wrong could never be intended by Congress, and this Court will not, we respectfully submit, put a construction on this 15th section, so much at variance with the previous decisions, and fraught with such oppressive consequences.

But there is no force in the argument that if the suit must be brought in the name of the party or parties representing at least an exclusive interest in some section of the United States, at the time when suit is brought, the plaintiff will be suing for damages to which others are entitled. This is every-day practice, familiar to the profession. Goodyear *vs.* McBurney, 3 Blatch., 32. A licensee whose rights are infringed may use the name of the patentee, or other party or parties representing the legal title, and thus recover through the legal plaintiff damages for the invasion of his rights.

It is not necessary in order to sustain the position taken by the defendants (as seems to be assumed by the plaintiff's argument,) that the assignment of an existing unexpired patent

carries with it a transfer of the right to damages for infringement committed before such assignment; and yet such is believed to be the case. The rules of the common law do not apply to the title to patent rights, nor to the transfer or recovery of damages for the infringement of such rights. "This monopily did not exist at common law, and the rights therefore which may be exercised under it cannot be regulated by the rules of the common law."

Gayler *vs.* Wilder, 10 Howard, 494.

"It is created by Act of Congress, and no rights can be acquired in it unless authorized by statute, and in the manner the statute provides." *Idem.*

A patent is a personal right in the nature of an incorporeal hereditament, though of limited duration. It would not be assignable were it not for the statute. See

Blanchard *vs.* Eldridge, 1 Wall., Jr., 337.

Brooks *vs.* Byam, 2 Story, 525.

Damages are duly recoverable for infringement of a patent by virtue of the Act of Congress, and are, we argue, incident to the patent, and the right to recover damages is part of the grant of the patent, and passes by assignment with it. It is said by the Supreme Court in a case already cited: "By the 11th Section of the Act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if he assigns a *part* under this Section it must be an undivided portion of *his entire interest under the patent*, placing the assignee on an equal footing with himself."

Gayler *vs.* Wilder, 10 Howard, 494.

The Patent Act of 1793 expressed the idea thus: "The assignee shall thereafter stand in the place of the original inventor both as to right and responsibility." The assignee takes the inventor's place, as holder of the title to the patent, he, and he only, has the right *to sue* for previously accruing damages; and whether he has the right to retain them, or could be compelled in equity to account to the previous owner or owners thereof, is a question that does not concern us here. And what is true of

an assignee is also true of the patentee and his assignee, who together represent such an exclusive interest in the patent as entitles them to sustain the action.

There is believed to be no instance of a patentee who had parted by assignment with his entire interest in a patent bringing suit, after such assignment, for damages for infringement which accrued during the time when he owned the patent; and if this cannot be done, so neither can a patentee who has transferred an undivided half of his patent to another bring suit for previous infringements, without joining his assignee as plaintiff. And this is what this plaintiff ought to have done.

If this action can be sustained as brought, then these defendants are liable to another suit, in the name of this plaintiff and Wilson Jones, for infringement committed *since* the assignment to Jones, and *prior to the commencement of the present suit:* which multiplicity of suits is the evil which the 14th Section of the Act of 1836 was intended to cure.

The case of tenants in common of real estate has no analogy to the present case, simply because the Patent Act of 1836 requires that all the parties representing the exclusive right shall be joined as plaintiffs.

It is hardly requisite to consider the question of the assignment of unliquidated damages, as it is not necessary to the decision of the present case, and is not supposed to have any force as against the proposition that the assignee of a patent may maintain an action for damages for infringement of the patent committed prior to the date of the assignment by which he acquired title.

Claims growing out of and adhering to property may pass by assignment of the property.

Comegys *vs.* Vasse, 1 Pet., 213.

The right of indemnity for unjust capture of a vessel is a right attached to the ownership of the property itself, and passes by cession.

Same case, 1 Pet., 213.

Randall *vs.* Cochran, 1 Ves., 98.

In like manner the right of indemnity for the unauthorized use of a patented machine is a right existing solely by virtue of the Act of Congress, and is by the Act of 1836, Section 14, attached to the ownership of the patent, and passes by the assignment of the patent without being expressly mentioned.

The assignments to Pierce and Black, and to Davis, Lawrence & Co. were recited in the defendant's plea as being neces sary to show what remaining interest the plaintiff had in the patent at the time the suit was brought. The former reduces his title to a mere sectional right, and the latter still further cuts that sectional right down to a fraction or undivided half, and therefore a *non* exclusive right, within a specified part of the United States.

The counsel for the defendants regret that they failed to make their argument understood by the plaintiff's counsel (as in his brief stated), but they were understood by the Court below, and would fain hope that they make their single and simple point intelligible to this higher tribunal.

It is respectfully submitted that on the title admitted, by the demurrer, to be in the plaintiff, he had no right under the Act of Congress to bring this action without joining as co-plaintiffs the joint owners of the exclusive right in the patent, and that there was, therefore, no error in the decision of the Circuit Court.

H. BALDWIN, JR.,
W. BAKEWELL,
Counsel for the Defendants.

LEWIS MOORE, Plaintiff in Error, *vs.* JAMES MARSH, P. BEAVER, CHARLES C. SHARKLEY and ELISHA SHARKLEY, Defendants in Error.	In the Supreme Court of the United States. December Term, 1868.

REPLY TO ADDITIONAL BRIEF OF PLAINTIFF IN ERROR.

Counsel for plaintiff in error has filed an additional brief in this case, apparently for the sole purpose of introducing into his argument the case of *Dean vs. Mason*, 20 How. 198.

I desire to offer a few remarks on behalf of the defendants in error, by way of reply.

In relying upon the case of *Dean vs. Mason*, it seems to me that the learned counsel for the plaintiff in error entirely misapprehends the point raised by the defendants here. The case of *Dean vs. Mason* has no application to this case, because,

1st. In that case, Mason, one of the plaintiffs below, parted with his interest not only *after suit brought*, but after final decree and perpetual injunction against the defendant. It was an assignment *pendente lite*, which, as the Supreme Court say, could not affect the rights of the defendant, who sought to reopen the case and obtain leave to file an answer, although the Mas-

ter's report did not extend beyond the date of the assignment.

On this point the Supreme Court simply decided that the assignees *in that case* ["these assignees]" could have no interest in a suit brought before their rights accrued.

And 2d. In *Dean vs. Mason*, the plaintiff below, Mason, had *no title in the patent*, merely a right to use the Woodworth planing machine in the city of Providence; he was merely a *licensee*. Accordingly the owners of the patent were joined with him as plaintiffs, although they had no interest in the *damages*. for Mason having no title in the *patent* could not sue alone. But it was Mason alone who made the assignment of his license to Baker & Smith, as appears by the opinion of the Supreme Court (20 How. 204). The correctness of this decision cannot be questioned, but it has no bearing whatever on the question raised in the present case.

In this case ~~Marsh~~ Moore, the plaintiff, assigned an undivided half of his patent to Wilson Jones on the 24th of February, 1865, and brought this suit against these defendants, Marsh *et al.*, in November, 1866. Thus when he brought this suit, and for some time previous, the plaintiff was not possessed of any exclusive interest in the patent; and as Mr. Justice Nelson decides in *Suydam vs. Day*, 2 Blatch. 23, under the 14th section, in connection with the 11th section, of the Act of 4th July, 1836, "an action is only given to such party—composed of one or more persons—as possesses *the whole interest in the patent*."

At the hearing he announced his declaration restricting his claim for damages to the time prior to

the date of the assignment to Jones, thus leaving these defendants open to another suit at the instance of the same plaintiff and Jones, for damages accruing prior to the commencement of the first suit.

This assignment was not *pendente lite*, as was the transfer in *Dean vs. Mason*; and it was an assignment of a *half interest in the patent*, while the transfer in *Dean vs. Mason* was a mere transfer of a license.

The law relative to the assignment of patents and the effect of such transfers on the rights of the parties, finds no analogy in the principles or rules of the common law. A patent is, in itself, a mere *right*, and was not assignable at common law. This is regulated exclusively by the acts of Congress. It is the *exclusive ownership* of the *patent* that enables a party to sue for damages for its infringement; and all the parties interested in the patent at the time of infringing the suit must be made parties. Hence an exclusive licensee, although entitled to the pernancy of all the damages, cannot sue without joining all owners of the patent, although they have no real interest in the *suit*, but only in the *patent*. The case of *Dean vs. Mason* is an example of this.

The adoption of the principle contended for by the learned counsel for the plaintiff, would, it is respectfully submitted, be at variance with the provisions of the 14th section of the Act of 4th July, 1836, as well as the decisions of this Court.

WILLIAM BAKEWELL,
of Counsel with Defendants in Error.